

REMARKS

By this amendment, claims 6, 36-41, 44, and 45 have been amended and claim 48 has been added. Claims 6-12 and 36-48 are currently pending. Of these, claims 6, 36, and 48 are independent.

In the Office Action,¹ the Examiner rejected claims 6 and 36 under 35 U.S.C. § 112, first paragraph; rejected claims 6-8, 36-38, and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Modeling Business Rules with Situation/Activation Diagrams by Lang et al. ("Lang") in view of U.S. Patent No. 5,764,953 to Collins et al. ("Collins"); and indicated that claims 9-12, 39-41, and 47 would be allowable if rewritten to overcome the 35 U.S.C. § 112, first paragraph, rejections, and if rewritten in independent form to include all of the limitations of the base claims and any intervening claims. Applicants appreciate the Examiner's indication of allowable subject matter in claims 9-12, 39-41, and 47. Applicants respectfully traverse the rejections under §§ 112 and 103(a) for the following reasons.

A. Collins not Listed in Notice of References Cited

As an initial matter, Applicants note that Collins is not listed in the Notice of References Cited attached to the Office Action. Therefore, Applicants respectfully request that Collins be included in a Notice of Reference Cited form accompanying the next Office communication.

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

B. Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 6 and 36 stand rejected under 35 U.S.C. § 112, first paragraph.

Specifically, the Examiner alleged that the term “non-deterministically” is not supported by the specification. Applicants respectfully disagree. However, to advance prosecution, Applicants have amended claims 6 and 36 to remove the term “non-deterministically.” Applicants have amended the claims to recite, among other things, “identifying a situation that matches the categorized received event . . . wherein identifying a follow-up situation considers any feedback provided by a consumer of the generated recommendation.” Applicants submit that this claim amendment and new claim 48 are supported at least by the paragraph beginning on page 22, line 5, of the specification, which describes a process of situation identification as follows:

Step 1) is similar to identifying the state in a classic workflow engine. The process of situation identification is, however, more powerful than simple state-transition models because it takes into consideration that the flow is interrupted after a situation is dealt with. Even if the situation prescribes the transition into a follow-up situation, as states do when the transition into a new state is made, the new situation does not occur unconditionally. *It also is not deterministic when the follow-up situation occurs. Often it depends on when and what feedback the user provides.* Interaction flow model 14a (see Figure 4B) may specify the usage of another model, e.g., a rule base, to evaluate what situation most appropriately reflects the real world situation.

(Emphasis added).

Accordingly, Applicants respectfully submit that the specification provides adequate support for the amendments to claims 6 and 36. In addition, Applicants

respectfully request withdrawal of the § 112, first paragraph, rejection of claims 6 and 36. Furthermore, Applicants respectfully submit that the paragraph of the specification quoted above provides adequate support for the term “non-deterministically” as used in claim 45.

C. Claim Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 6-8, 36-38, and 42-46 under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of Collins. No *prima facie* case of obviousness exists with respect to claims 6-8, 36-38, and 42-46 at least because the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th ed., rev. 4, Oct. 2005). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, not in applicant’s disclosure.” M.P.E.P. § 2143 (8th ed., rev. 4, Oct. 2005).

For example, amended claim 6 recites a method for executing an interaction flow model, comprising, among other things, “identifying a situation that matches [a] categorized received event . . . wherein identifying a follow-up situation considers any

feedback provided by a consumer of [a] generated recommendation.” Independent claim 36, as amended, contains similar language.

Lang discloses a graphical object-oriented language, called Situation/Activation diagrams, for modeling business rules. See Abstract. According to Lang, situation diagrams graphically define situations that trigger business rules. See p. 456, col. 1. The business rules express how an external observer, e.g., a swift clerk, could monitor calendar time and a database state to recognize predefined situations and to react to them accordingly in order to meet a company’s business policy. See p. 455, col. 1. However, recognizing predefined situations by monitoring calendar time and a database state does not constitute “identifying a situation . . . wherein identifying a follow-up situation considers any feedback provided by a consumer of [a] generated recommendation,” as required by amended claim 1.

Furthermore, a situation, as defined by Lang, is “a general term for events” and may be provided by a calendar manager, recognized by special hardware components, or generated explicitly by users. See p. 457, col. 2. Lang also refers to two types of user-generated events: a user-issued repair transaction (see p. 462, col. 2) and a user abort of a rule execution (id.). However, generating situations, issuing repair transactions, and aborting rule transactions do not constitute “feedback provided by a consumer of [a] generated recommendation.” Moreover, Lang does not disclose that identifying a situation considers any of these events, as required by claim 1.

The Examiner took Official Notice that recommending an action to be taken for an event is well known in the business art (which Applicants do not concede). The

Official Notice fails to cure the deficiencies of Lang identified above. Collins, relied on for its disclosure of a system that integrates decision-making processes and generates decisions in response to events representing changes in a domain model, similarly fails to cure the deficiencies of Lang identified above. Therefore, no *prima facie* case of obviousness exists with respect to independent claims 6 and 36. Moreover, no *prima facie* case of obviousness exists with respect to claims 7-12, 37-38, and 42-46 at least by virtue of their dependency on one of independent claims 6 and 36. Accordingly, the § 103(a) rejections of claims 6-8, 36-38, and 42-46 should be withdrawn.

D. New Claim 48

Applicants respectfully submit that new claim 48 is allowable over the references applied by the Examiner for at least the reason that the references, taken alone or in combination, fail to teach or suggest each and every element of claim 48.

New claim 48, although of different scope, contains some elements corresponding to the elements of claim 6 discussed above. For example, new claim 48 recites an apparatus having a processor and a memory containing programs, which, when executed using the processor, perform steps comprising, among other things, "identifying a situation that matches [a] categorized received event . . . wherein identifying a follow-up situation considers any feedback provided by a consumer of the generated recommendation." Accordingly, new claim 48 is allowable for at least the reasons set forth above.

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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